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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/747,942 | 12/27/2000 | Akira Haneda | 2583-107 | 3483 |

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ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER

NGUYEN, KIMBERLY T

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1774

DATE MAILED: 11/05/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,942

Applicant(s)

HANEDA ET AL.

Examiner

Kimberly T. Nguyen

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>8</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Allowable Subject Matter

The following is an examiner's statement of reasons for allowance of **claims 4 and 5**:
The cited prior of Berger et al., U.S. Pat. No. 6,165,592 does not suggest nor teach a print layer formed by printing with fluorescent pigment ink on at least one side of a base with coating or paper layers formed on both sides of said base having an opacity of 20-92%.

Response to Amendment

This action is in response to the amendment submitted on August 20, 2002.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Due to Applicants' amendments, the previous rejection of claims 4 and 5 under 35 USC 112, 2nd paragraph are withdrawn.

Claim Rejections - 35 USC § 103

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al., U.S. Pat. No. 6,165,592 as previously stated in the Office Action submitted on March 21, 2002.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al., U.S. Pat. No. 6,165,592 in view of Katagiri, U.S. Pat. No. 6,074,739 as previously stated in the Office Action submitted on March 21, 2002.

Response to Arguments

Applicants' argument filed August 20, 2002 have been fully considered but they are not persuasive.

On pages 3-6, Applicants argue that Berger does not teach the limitation of both of the two outer layers having an opacity of 20-29% as in instant claim 1. Examiner is not persuaded because Berger shows the base, fluorescent pigment ink layer, and outer opaque layers of metal (Figures 2-4). Absent any evidence to the contrary, it would have been obvious to one of ordinary skill in the art at the time the invention was made to duplicate this structure on both sides of a security document due to a reasonable expectation of success to provide security features to such documents, such as credit cards and bank notes, on both sides. Further, the limitation of the percentage of opacity is a result-effective parameter as it controls the amount of fluorescence viewed when illuminated through the opaque layers of the security document. As such, they are optimizable.

On page 6, Applicants argue that Berger does not teach or suggest the "print layer" as shown in claim 4 and similarly, in claim 1. It is not clear which layer in claim 1 is the "print layer." Examiner is also not persuaded because Berger definitely shows a fluorescent ink layer (column 6, lines 40-53).

On pages 7-8, Applicants argue that there is no motivation or reasoning for combining Berger and Katagiri because there is no evidence to establish that the metal layer of Berger and the paper layer of Katagiri are functional equivalents. Examiner disagrees because Katagiri shows that opaque substrate layers can comprise paper or metal (column 5, lines 50-60). Katagiri is used in combination with Berger to show that the metal opaque layer of Berger can be substituted with an opaque paper layer to provide the same function, i.e. opacity, because they are functional equivalents.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

